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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,610	03/29/2004	Brett Allison Taylor	104558-300	9705
30873 7590 09/24/2009 DORSEY & WHITNEY LLP INTELLECTUAL PROPERTY DEPARTMENT 250 PARK AVENUE NEW YORK, NY 10177				
EXAMINER				
PRONE, CHRISTOPHER D				
ART UNIT		PAPER NUMBER		
3738				
MAIL DATE		DELIVERY MODE		
09/24/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/810,610

**Applicant(s)**

TAYLOR, BRETT ALLISON

**Examiner**

CHRISTOPHER D. PRONE

**Art Unit**

3738

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,6-8,10-19,21-26,28,29,31,34,36-38,40,41 and 46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-8,10-16,25,26,28,29,31,34,36-38,40,41 and 46 is/are rejected.
- 7) ☒ Claim(s) 17-19 and 21-24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-846)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Priority Date**

The priority date of this application is its filing date 3/29/04.

### **Status of claims**

Claims 4, 5, 9, 20, 27, 30, 32, 33, 35, 39, and 42-45 are cancelled. Claims 1, 2, 6-8, 10-19, 21-26, 28, 29, 31, 34, 36-38, 40, 41, and 46 are pending.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3, 6-8, 10, 11, 26, 28, 29, 31, 36, 37, and 38, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. With respect to the elected embodiment shown in figures 18-19, the description of the articulation member is inappropriate and considered new matter. Independent claim 1 requires an articulation member with first and second articulation portions comprising pivotal joint members. This is not an accurate description because there is no single articulation member in figures 18-19 that comprises first and second

portions that meet the use language. Figures 18-19 clearly have 2 articulation members. It is inappropriate to call them a single member because they are clearly separated by body member 154, which makes it impossible for them to be disposed in a particular location as described in line 24. The applicant is advised to amend the claims to read a "pair of articulation members including: a first articulation member having ...a second articulation member ..." The language should mimic how independent claim 12 defines articulation members.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 6-8, 10-16, 25, 36-38, 40, and 46 are rejected under 35 U.S.C. 103 as being unpatentable over Berry et al. USPN 2005/0060034 A1 in view of Erickson et al. USPN 6,368,350 B1

Berry discloses the invention substantially as claimed being a vertebral prosthesis shown in figure 9b comprising first and second support members 22 that allow for rotational and pivotal movements along an anterior, posterior and lateral axis, first and second associated articulation members 30, and body member 122. Berry further discloses the support portions comprise a tapered projection portion 34 that forms a pivotal engagement with a first articulation portion 36. In regards to claims 36-

38 Berry discloses that the components can be made from a variety of materials including radiopaque metals and radiolucent polymers. Berry further discloses that different members can be made of different materials which is being considered to read upon having radiopaque inserts.

However, Berry does not disclose that the articulation members allow translatable movement.

Erickson teaches the use of a spinal prosthesis that comprises an articulation member that allows translational movement in the same field of endeavor for the purpose of restoring the natural movement of the spine.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the articulation portion 30 of Berry to be translatable as taught by Erickson in order to restore the patient's natural spinal movements.

Claims 26, 28, 29, 31, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berry as modified by Erickson as applied to claims 1-3, 6-8, 10-16, 25, 36-38, 40, and 46 above, and further in view of Gill et al. USPN 6,113,637.

Berry as modified by Erickson discloses the invention substantially as claimed being described supra. However, the combination does not disclose that the support members comprise a fastener mount having a diagonally mounted opening.

Gill teaches the use of a spinal prosthesis that comprises fastener mount having a diagonally mounted opening for receiving a fastener in the same field of endeavor for the purpose of securing the implant to the spine.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the support members of Berry to include the fastener mount having a diagonally mounted opening as taught by Gill in order to secure the implant in place.

Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berry as modified by Erickson and Gill as applied to claims 26, 28, 29, 31, and 34 above, and further in view of Johnson et al USPN 2002/0183761 A1.

Berry as modified by Erickson and Gill discloses the invention substantially as claimed being described supra. However, the combination does not disclose that the support members comprise a biologically active substance.

Johnson discloses an arthroplasty prosthesis that can deliver a biologically active substance to the implant site [0097].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the support members of Berry to include a biologically active substance as taught by Johnson in order to aid with the bodies healing and acceptance of the implant.

#### ***Allowable Subject Matter***

Claims 17-19 and 21-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments with respect to all claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **CHRISTOPHER D. PRONE** whose telephone number is (571)272-6085. The examiner can normally be reached on Monday through Fri 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher D Prone  
Examiner  
Art Unit 3738

/Christopher D Prone/

/Corrine M McDermott/  
Supervisory Patent Examiner, Art Unit 3738